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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,410	07/19/2001	Adam Rosen	13378-002001	7301

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EXAMINER	
SAADAT, CAMERON	
ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/909,410	Applicant(s) ROSEN, ADAM
	Examiner Cameron Saadat	Art Unit 3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 6-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

In response to amendment filed 9/22/03, claims 1-4, 6-15 and newly added claims 16-19 are pending in this application. Claim 5 has been cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, and 6-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al. (US Patent Application Publication 2001/0053967 A1; hereinafter Gordon).

Regarding claim 1, Gordon discloses a method comprising enabling electronic posting of a performance that expresses a position of a party on an issue, storing the posted performance digitally (¶ 61), enabling at least two different individuals at two different locations to observe at least portions of the performance (¶ 29), and enabling each of the individuals to post electronically feedback relating to the persuasiveness of the performance of the party with respect to the issue (¶ 111).

Gordon further discloses a method that enables electronic posting of an audio, spoken legal argument for access by individuals at different locations. It is not explicitly stated that the audio information may be posted from a *telephone*. However, Matsunsami discloses an audio posting system wherein audio is posted from a telephone and provided over a computer network (¶ 10). Hence, it would have been obvious to an artisan to modify the method of posting audio described in Gordon, by allowing posting of audio through a telephone, in light of the teachings of Matsunsami, in order to allow telephones and computers to be used as transmittal terminals through the Internet so that a voice file can be distributed to a plurality of computer terminals from a telephone, thereby providing a more portable audio posting system.

Regarding claim 2, Gordon discloses a method in which the position on the issue comprises a legal argument related to a litigation issue (¶ 29).

Regarding claim 3, Gordon discloses a method in which the performance includes audio material (¶ 60).

Regarding claims 4 and 9, Gordon discloses a method in which the performance includes graphical material (¶ 60).

Regarding claim 6, Gordon discloses a method in which the two different individuals observe the performance at two different times (¶ 29)..

Regarding claim 7, Gordon discloses a method in which the performance is delivered as streaming digital information to the individuals (¶ 60).

Regarding claim 8, Gordon discloses a method in which the feedback is posted in the form of email or responses given through a website (¶ 79).

Regarding claim 10, Gordon discloses a method in which the electronic posting of the performance includes posting of timing information (¶ 65).

Regarding claim 11, Gordon discloses a method including analyzing the feedback from the individuals (¶ 113).

Regarding claim 12, Gordon discloses a method in which the individuals comprise jurors (¶ 29).

Regarding claim 13, Gordon discloses a method including enabling the designation of groups from which the individuals are to be drawn (¶ 65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US Patent Application Publication 2001/0053967 A1; hereinafter Gordon) in view of Matsunsami (US Patent Application Publication 2002/0031206 A1).

Regarding claims 14-19, Gordon discloses a method comprising the steps of: receiving a spoken argument (¶ 60), storing the argument as a digital file (¶ 61), making the argument available electronically to users at different locations as streaming media for performance to the users (¶ 29), and receiving feedback from individuals at different locations with respect to the persuasiveness of the argument. (¶111). Gordon further discloses a method that enables electronic posting of an audio, spoken legal argument for access by individuals at different locations. It is not explicitly stated that the audio information may be posted from a telephone. However, Matsunsami discloses an audio posting system wherein audio is posted from a telephone and provided over a computer network (¶ 10). Hence, it would have been obvious to a person of ordinary skill in the art to modify the method and system of posting audio described in Gordon, by allowing posting of audio through a *telephone*, in light of the teachings of Matsunsami, in order to allow telephones and computers to be used as transmittal terminals through the Internet so that a voice file can be distributed to a plurality of computer terminals from a more portable device (telephone).

Regarding claims 16-19, Gordon (¶ 65) discloses a method comprising electronic posting of timing information in order to organize trial data (audio, video, etc.).

Response to Arguments

Applicant's arguments filed 9/22/03 have been fully considered but they are not persuasive.

Applicant assert that the posting of "a performance that expresses a position of a party on an issue" is enabled from *a telephone*; and that nothing in Gordon or in Matsunsami suggests enabling posting of a performance that expresses a position of a party on an issue *from a telephone*.

However, the standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc., 800 F.2d 1091,1097, 231 USPQ 375, 379 (Fed. Cir. 1986).* The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972).* In this case Gordon discloses a method comprising enabling electronic posting of a performance that expresses a position of a party on an issue, storing the posted performance digitally (¶ 61), enabling at least two different individuals at two different locations to observe at least portions of the performance (¶ 29), and enabling each of the individuals to post, electronically, feedback relating to the persuasiveness of the performance of the party with respect to the issue (¶ 111). Gordon discloses all of the claimed subject matter with the exception of disclosing that the performance is posted via *telephone*. However, Matsunsami discloses an audio posting system wherein audio is posted from a telephone and provided over a computer network (¶ 10). Hence, in view of Matsunsami the references collectively teach and suggest modifying the method of posting of a performance described in Gordon, by posting information via telephone in order to allow telephones and computers to be used as transmittal terminals through the Internet so that a voice file can be distributed to a plurality of computer terminals from a telephone, thereby providing a more portable audio posting system.

Furthermore, the fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results. (See In re Lindberg, 194 F.2d 732, 93 USPQ 23 (CCPA 1952)).

Applicant further asserts that the examiner's cited (¶ 65) does not disclose anything about include posting of timing information in the performance. However, Gordon (¶ 65) does disclose a method comprising electronic posting of timing information in order to organize trial data (audio, video, etc.).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS

Teresa Walberg
Supervisory Patent Examiner
Group 3700